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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,682	10/27/2003	Joseph Wittemer	ATM-2360	2063
217 7590 12/11/2007 FISHER, CHRISTEN & SABOL 1725 K STREET, N.W. SUITE 1108 WASHINGTON, DC 20006			EXAMINER GEHMAN, BRYON P	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/692,682

**Applicant(s)**

WITTEMER, JOSEPH

**Examiner**

Bryon P. Gehman

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 19 and 30, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 10-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 10, 11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3728

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007 has been entered.

2. Claims 1, 16 and 17 are objected to because of the following informalities: In claim 1, line 12, claim 16, line 12 and claim 17, line 11, "part of surface portion" is ungrammatical and should include an appropriate article.. Appropriate correction is required. In claim 16, line 8, "substantially entire area" is ungrammatical and should be --substantially the entire area--.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, 5, 10-11 and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 5-6, "does not have any hole therein and is continuous and uninterrupted is indefinite, as such" repeats itself and is redundant. The phrase should be --is continuous and uninterrupted so as to not have any hole therein--, or merely --is continuous and uninterrupted-- to be clear

Art Unit: 3728

and unambiguous. See also claim 16, lines 5-6. In claim 1, line 8, "printed on one of one side or both sides" is indefinite, as it is unclear whether "one" is one side only or if the option includes both sides being printed. The phrase "one of one or both sides" is indefinite, as one of one side is one and one of both sides is one, while --printed on one or both sides-- is clear of an alternative being defined. See also claim 5, lines 6-7, claim 16, line 8 and claim 17, lines 7-8.

In claim 16, line 8, "substantially entire area of the cover" is misleading, as such renders "a remaining portion of the cover film is permanently bonded" inconsequential, as the peelable area is just about the entire area and the permanently bonded area is accordingly inconsequential. However, the disclosed peelable "entire area of the cover" is not "substantially all" of the area, as such is demonstrated to be a substantial, but not for all intents and purposes, practically all of the area.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 5, 10 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Counts et al. (5,341,930) in view of Kaufmann (5,389,415). Counts et al. disclose a packaging bag (Figures 1 and 2) with a front wall (14) and a rear wall (12) in which the front wall and rear wall are bonded together along a peripheral edge

Art Unit: 3728

(column 6, lines 39-47), each of the front wall and the rear wall being continuous and uninterrupted so as to not have any hole therein; at least one of the front wall and rear wall bonded to a cover film (16) which is printed on one or both sides, substantially the entire area of the cover film being bonded to and peelable from the at least one of the front wall and rear wall, and at least one of the front wall and rear wall of the packaging bag printed on the outside of the bag (at 20). Kaufmann disclose a substantial portion of a cover film (2) bonded to and peelable from a package and a remaining portion (5) of the cover film permanently bonded to a packaging bag in an edge area. To employing would have been obvious in order to It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide modify the packaging bag of Counts et al. with the peelable and permanent seal combination teaching of Kaufmann as claimed, as such a modification would predictably permanently retain the cover film with the bag of Counts et al., yet allow its partial peeling to ascertain text hidden beneath the cover film, as suggested by Kaufmann.. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396.

As to claim 2, Counts et al. disclose a first packaging film (14), a second packaging film (12) and a cover film (16).

As to claim 10, Counts et al. disclose bonding of the cover film in an edge area.

As to claim 14, Kaufmann further disclose employing permanent adhesive (see column 2, lines 43-55).

As to claim 15, since the prior art combination discloses printing in general, and applicant discloses register printing to be known in the field, to employ the commonly known register printing process would have been obvious to one of ordinary skill in the art and would fail to define any new and unexpected result by its employment.

7. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Muir Jr. et al. (6,767,604). Muir Jr. et al. disclose the front wall and the rear wall of a similar bag being of the same packaging film by folding (see column 3, lines 46-61). To provide the front and rear walls of Counts et al. as folded portions of the same material would have been obvious, as it is well-known in the bag field to provide a bag by folding a single sheet, as disclosed by Muir Jr. et al..

8. Applicant's arguments with respect to claims 1-3, 5, 10-11 and 14-17 have been considered but are moot in view of the new grounds of rejection.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant maintains to believe that any modification of one reference with the teaching of another "destroys" the modified reference. This argument can be used for

Art Unit: 3728

any construction, as employing applicant's rationale, any change in an existing structure "destroys" the existing structure. The examiner, nor the Patent Office, recognizes that any modification destroys a base reference by it merely being modified. Thinking in a common sense way, would replacing a container with an entirely removable closure on a container with a hinged or tethered closure "destroy" the container? Not in the examiner's vision, it would just change the capabilities of the container in an expected way. The modification of Counts et al. in view of Kaufman is also maintained to be obvious in order to obtain a non-removable cover. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kaufman discloses a printed cover film being reusably peelable from a bag and resecurable thereto, to render the packaging bag recoverable by the printed cover film, which is what is desired by applicant in his packaging bag.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

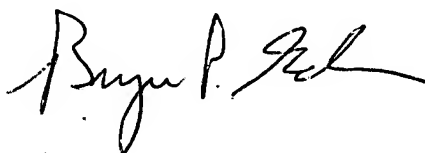
Art Unit: 3728

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG